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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,471	07/01/2003	Reiko Ueno	OGOH : 123A	1068
27890 7590 08/09/2007 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER REILLY, SEAN M	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/609,471

Applicant(s)

UENO ET AL.

Examiner

Sean Reilly

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on May 15, 2007. Claims 11-26 are presented for further examination.

Response to Arguments

Applicant's asserts that the prior art of record failed to disclose an appliance connected to a network transmits data *only* to a *predetermined* particular router on the network. Examiner respectfully disagrees with Applicant's assertion. At the very least, in Balassanian's system, content from a user on WAN 160 that is destined for an appliance on some LAN (such as LANs 150 and 190) must pass through the gateway for that LAN (e.g. gateway 155 or 195). See for example the explicit discussion in ¶ 48 where a user on LAN 190 sends data out onto WAN 160 and then over to an appliance in LAN 150. In this example *gateway* 155 acts in just that capacity, i.e. as a gateway for all content to the LAN 150. Furthermore the gateway 155 is certainly *predetermined* since it is specified as the destination in the request (see inter alia, ¶ 48, "The content is encapsulated in a header containing the target appliance routing address string, which here is the routing address string of gateway interface 155.") Thus, Balassanian clearly disclose an appliance connected to a network transmits data *only* to a *predetermined* particular router on the network.

Applicant's argument that the declaration filed on May 15, 2007 overcomes the Balassanian reference is not persuasive for the reasons stated below.

Declarations Under 37 CFR 1.131

The declaration filed on May 15, 2007 is deficient and fails to overcome the Balassanian reference. The affidavit fails to satisfy any of the requirements set forth under 37 CFR 1.131.

The evidence submitted is **insufficient for establishing conception and diligence** for a date prior to the date of reduction to practice of the Balassanian reference.

Applicant's evidence is certainly deficient and fails to meet any of the requirements for proving conception and diligence. Simply put Applicant has failed to submit any evidence that demonstrates conception or diligence. The declaration submitted by Applicant amounts to nothing more than general allegations of conception and diligence.

While conception is the mental part of the inventive act, **it must be capable of proof**, such as by **demonstrative evidence or by a complete disclosure to another**. Further a conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909). What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible

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explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970).

Applicant's declaration filed May 15, 2007 point #4 states that Exhibit A contains a copy of Japan Application 11-199024 file July 13, 1999. This exhibit is not in the instant application's file wrapper. Furthermore an English copy of Japan Application 11-199024 is not contained anywhere in the file wrapper. Thus, Examiner cannot consider this alleged evidence of conception.

Furthermore, even if Applicant can prove conception through the Japanese application, Applicant has failed to provide **any affirmative acts or acceptable excuses** during the period which diligence is required. For instance Applicant failed to provide a single affirmative act or acceptable excuse during the period between Balassanian's filing on February 4, 2000 and Applicant's PCT filing on December 27, 2000. Applicant must submit **affirmative acts or acceptable excuses** during the period which diligence is required in order to account for these large gaps of inactivity.

Applicant is invited to review MPEP 715.07 for further guidance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 11-13, 15, 17-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Balassanian (U.S. Patent Application Publication 2005/0021857; hereinafter Balassanian).

2. With regard to claim 11, Balassanian disclosed a method of routing data through a router connected to a plurality of networks, the method comprising:

transmitting all data for a network (e.g. LAN, Figure 1b) other than a first network (e.g. a WAN, Figure 160) of a plurality of networks in a home bus system (e.g. at the least the LAN and WAN networks) only to a predetermined particular router (e.g. Gateway interface 165, Figure 1b, wherein all traffic from the WAN for appliances that reside in the LAN is routed through gateway interface 165; which is *predetermined* since it is specified in the transfer request, see inter alia ¶ 48) which is one router among a plurality of routers connected to the first network (e.g. when WAN 160 is the internet thousands of routers are connected, see inter alia ¶s 03 and 34);

3. In considering independent claim 12, Balassanian discloses an appliance connected to a first network among a plurality of networks, the appliance comprising:

- means for stipulating a predetermined particular router (“network address of gateway”) among a plurality of routers (“series of hops”) connected to the first network (fig. 1b, #160, WAN) [¶0037, ¶0048] of a plurality of networks in a home bus system (e.g. at the least the LAN and WAN networks); and

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- means for transmitting all data for a network other than the first network (fig. 1b, #195, LAN) to the predetermined particular router (fig. 1b, #165, “gateway”) [¶0037, ¶0048].

4. In considering independent claims **13 & 15**, Balassanian discloses a method of transmitting data from an appliance connected to a first network among a plurality of networks, the method comprising:

- transmitting data for a network other than the first network (fig. 1b, #195, LAN) of a plurality of networks in a home bus system (e.g. at the least the LAN and WAN networks) only to a predetermined particular router (fig. 1b, #165, “gateway”) which is one router among a plurality of routers (“series of hops”) connected to the first network (fig. 1b, #160, WAN) [¶0037, ¶0048]., wherein,
- the data comprises identification information of the predetermined particular router (“network address of gateway”) as address information within the first network [¶0037, ¶0048].

5. In considering independent claim **17**, Balassanian discloses a method of transmitting data from a first appliance connected to a first network among a plurality of networks, the first appliance having identification information indicating the first network, the method comprising:

- stipulating a particular router (“network address of gateway”) among a plurality of routers (“series of hops”) connected to the first network (fig. 1b, #160, WAN) [¶0037, ¶0048]; and

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- transmitting data for a second appliance (fig. 1b, #175-190) having identification information indicating a network different from the first network (fig. 1b, #195, LAN) only to the particular router (fig. 1b, #165, “gateway”) [¶0037, ¶0048].
6. In considering claims **18 & 20**, Balassanian discloses:
- transmitting data for a third appliance having identification information indicating a network same as the first network directly to the third appliance [fig. 8, step 815, ¶0045, claim 1].
7. In considering independent claim **19**, Balassanian discloses an appliance connected to a first network among a plurality of networks, the appliance comprising:
- means for holding identification information of the first network [fig. 2, “Table of Known Appliances, ¶0037];
 - means for stipulating a plurality router (“network address of gateway”) among a plurality of routers (“series of hops”) connected to the first network (fig. 1b, #165, WAN) [¶0037, ¶0048]; and
 - means for transmitting data for a second appliance (fig. 1b, #175-190) having identification information indicating a network different from the first network (fig. 1b, #195, LAN) only to the particular router (fig. 1b, #165, “gateway”) [¶0048].

With regard to claims 21-26, Balassanian disclosed the data is transmitted in a home bus system comprising household appliances (see inter alia, Figures 1a and 1b), and further

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comprising transmitting data between a pair of sub-network through an electric household appliance (e.g. "the resources on an appliance are a sub-network and are routing between two appliances becomes the same problem as routing between two subnets on the Internet" ¶ 29).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims **14 & 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Balassanian**, further in view of **Teraoka (US 6,292,836)**.

10. In considering claims **14 & 16**, while Balassanian discloses a method of transmitting data from a first network to another network via a router, Balassanian does not explicitly disclose the detailed contents of the data. Nonetheless in analogous art, Teraoka discloses a method of transmitting data from a first network to another network via a router (fig. 1, col. 4, lines 22-34). Teraoka further discloses:

- the data further comprises transmitter identification information comprising identification information of a network of the appliance ("transmitting host address") and identification information of the appliance ("transmitting host identifier") and receiver identification information comprising identification information of a network of a transmitting end

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- appliance (“receiving host address”) and identification information of the transmitting end appliance (“receiving host identifier”) [fig.2, col. 4, lines 22-34].; and
- the transmitter identification information and the receiver identification information are provided in a data region (“header”) of the data [fig.2, col. 4, lines 22-34].

Given the teachings of Teraoka, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system/method disclosed by Balassanian where a data region of the data would contain identification information. The motivation, as suggested by Teraoka, would be so that the identification information could be read by the routers transited by the data and forwarded to the appropriate destination [col. 4, lines 22-34].

Conclusion

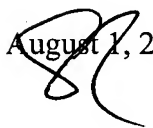
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 August 1, 2007


JASON CARDONE
SUPERVISORY PATENT EXAMINER